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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,364	09/12/2003	Eric Meyerhofer	51091/RAG/F392	6757

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EXAMINER

CULLER, JILL E

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/661,364	Applicant(s) MEYERHOFER ET AL.	
	Examiner Jill E. Culler	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006 and 07 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-10, 12, 13, 24-29 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 9, 29, 32, 36/29 and 36/32 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10, 12-13, 24-28, 31, 33-35, 36/24-28, 36/31 and 36/33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8, 24, 31, 36/24 and 36/31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,594,233 to Kenneth et al. in view of Benson et al..

With respect to claims 1 and 8, Kenneth et al. teaches a multi-media printer, 16, comprising: a print module comprising two or more heads, including one or more heads for reading and writing a different type of card, the one or more heads selected from the group including a magnetic strip card read/write head, 24, and a smart card connector, 26, see column 4, lines 16-19; and a single media drive adapted to couple a card inserted into the multi-media gaming printer to each of the heads, see column 4, lines 19-25, and a controller, 35, coupled to the two or more heads and the single media drive, the controller adapted to manipulate the inserted card using the capabilities of the two or more heads, see column 5, lines 1-44, and a media motion sensor, 22, see column 5, lines 54-63.

Kenneth et al. does not teach that the print module comprises a thermal card read/write head comprising a thermal write head and an optical read head.

Benson et al. teaches a multi-media printer comprising a print module including two or more heads, one of the heads being a thermal card read/write head, comprising a thermal write head and an optical read head. See column 3, line 49 - column 4, line 39 and column 12, lines 43-62.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Kenneth et al. to include a thermal card read/write head, as taught by Benson et al., in order to be able to provide human readable information on the card.

With respect to claims 24 and 31, Kenneth et al. teaches a multi-media printer, 16, comprising: a print module for manipulating cards comprising different types of media, the print module comprising: a first head, 24, for manipulating a first type of card; a second head, 26, for manipulating a second type of card, the first type of card and the second type of card being different card types; see column 4, lines 16-19, and a single media drive adapted to couple a card inserted into the multi-media gaming printer to each of the heads, see column 4, lines 19-25, and a controller, 35, for controlling the print module, the controller adapted to detect the type of the inserted card using the heads, see column 5, lines 1-44, and a media motion sensor, 22, see column 5, lines 54-63.

Kenneth et al. does not teach that first head comprises a thermal card read/write head comprising a thermal write head and an optical read head.

Benson et al. teaches a multi-media printer comprising a print module including two or more heads, one of the heads being a thermal card read/write head, comprising

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a thermal write head and an optical read head. See column 3, line 49 - column 4, line 39 and column 12, lines 43-62.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Kenneth et al. to include a thermal card read/write head, as taught by Benson et al., in order to be able to provide human readable information on the card.

With respect to claims 36/24 and 36/31, Kenneth et al. teaches that the second head is selected from the group including a magnetic strip card read/write head, 24, and a smart card connector, 26. See column 4, lines 16-19.

3. Claims 2, 25 and 36/25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenneth et al. in view of Benson et al., as applied to claims 1, 8, 24, 31, 36/24 and 36/31 above, and further in view of JP 05169762 to Asakawa.

With respect to claims 2 and 25, Kenneth et al. and Benson et al. teach all that is claimed, as in the above rejection of claims 1, 8, 24, 31, 36/24 and 36/31 except that the single media drive further comprises an articulated media drive adjustable to accommodate media with various thicknesses.

Asakawa teaches an articulated media drive, adjustable to accommodate media with various thicknesses. See abstract.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the invention of Kenneth et al. to have the articulated media drive of Asakawa in order to be able to process a wider variety of cards.

With respect to claim 36/25, Kenneth et al. teaches that the second head is selected from the group including a magnetic strip card read/write head, 24, and a smart card connector, 26. See column 4, lines 16-19.

4. Claims 3-5, 26-28, 36/36, 36/27 and 36/28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenneth et al. in view of Benson et al., as applied to claims 1, 8, 24, 31, 36/24 and 36/31 above, and further in view of U.S. Patent No. 5,882,127 to Amano.

With respect to claims 3-4 and 26-27, Kenneth et al. and Benson et al. teach all that is claimed, as in the above rejection of claims 1, 8, 24, 31, 36/24 and 36/31 except for a media magazine coupled to the controller and operable to receive and transmit media from and to the print module, and a media quantity sensor.

Amano teaches a printer having a media magazine, 21, coupled to a controller and operable to receive and transmit media from and to the print module, and a media quantity sensor, 55. See column 11, line 65 - column 12, line 16 and column 15, lines 54-58.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the invention of Kenneth et al. to have the media magazine and quantity sensor of Amano in order to deliver media to the printer in a controlled manner.

With respect to claims 5 and 28, Kenneth et al. teaches a read/write media information memory. See column 5, lines 8-11.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the memory of Kenneth et al. with the media magazine structure taught by Amano in order to have better control over the media feeding process.

With respect to claims 36/26, 36/27 and 36/28, Kenneth et al. teaches that the second head is selected from the group including a magnetic strip card read/write head, 24, and a smart card connector, 26. See column 4, lines 16-19.

5. Claims 10, 33 and 36/33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenneth et al. in view of Benson et al., as applied to claims 1, 8, 24, 31, 36/24 and 36/31 above, and further in view of U.S. Patent No. 6,364,550 to Petteruti.

With respect to claims 10 and 33, Kenneth et al. and Benson et al. teach all that is claimed, as in the above rejection of claims 1, 8, 24, 31, 36/24 and 36/31 except for an external communication port.

Petteruti teaches a printer having an external communication port, 110. See column 4, line 63 - column 5, line 23.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the invention of Kenneth et al. to have the external communication port of Petteruti to be able to more readily communicate between the printer and another external device.

With respect to claim 36/33, Kenneth et al. teaches that the second head is selected from the group including a magnetic strip card read/write head, 24, and a smart card connector, 26. See column 4, lines 16-19.

6. Claims 12-13, 34-35, 36/34 and 36/35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenneth et al. in view of Benson et al., as applied to claims 1, 8, 24, 31, 36/24 and 36/31 above, and further in view of U.S. Patent No. 6,104,311 to Lastinger.

With respect to claims 12 and 34, Kenneth et al. and Benson et al. teach all that is claimed, as in the above rejection of claims 1, 8, 24, 31, 36/24 and 36/31 except for a capacitance security feature head adapted to read a capacitor structure in the inserted card, the capacitor structure comprising conductive inks.

Lastinger teaches a capacitance security feature head, 32, adapted to read a capacitor structure in an inserted card, see column 8, lines 23-51, the capacitor structure comprising conductive inks. See column 8, lines 2-7.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the invention of Kenneth et al. to have the capacity security feature head of Lastinger in order to be better able to identify the status of the card when it is inserted in the printer.

With respect to claims 13 and 35, Kenneth et al. and Benson et al. teach all that is claimed, as in the above rejection of claims 1, 8, 24, 31, 36/24 and 36/31 except for a

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radio frequency sensor security feature head adapted to read radio waves generated by radio frequency resonators embedded in the inserted card.

Lastinger teaches a radio frequency sensor security feature head, 32, adapted to read radio waves generated by radio frequency resonators embedded in the inserted card. See column 8, lines 23-51.

It would have been obvious to one having ordinary skill in the art at the time of the invention to further modify the invention of Kenneth et al. to have the radio frequency sensor security feature head of Lastinger in order to be better able to identify the status of the card when it is inserted in the printer.

With respect to claims 36/34 and 36/35, Kenneth et al. teaches that the second head is selected from the group including a magnetic strip card read/write head, 24, and a smart card connector, 26. See column 4, lines 16-19.

### ***Allowable Subject Matter***

7. Claims 6, 9, 29, 32, 36/29 and 36/32 are allowed.

### ***Response to Arguments***

8. In response to applicant's argument that the prior art does not disclose a thermal card read/write head for writing to thermally reactive material, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

intended use, then it meets the claim. Although the print media disclosed by the prior art reference does not appear to be thermally reactive material, it would appear that the disclosed apparatus is capable of printing on any printing medium, and therefore capable of performing the intended use disclosed in the amended claim language.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 4,168,845 to Oeda et al. discloses a thermal write head for writing to thermally reactive material. It should be noted that this technology is well known in the art and would not, by itself, constitute a patentable distinction for an apparatus.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-F 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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